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EXAMINER

SCHILLING, RICHARD L

ART UNIT PAPER NUMBER

1752

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036155

Applicant(s)

Anderson et al

Examiner

RL Schelling

Group Art Unit

1752

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 10-22-03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-14, 19-48 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-14, 19-48 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 19-28, 30-32, 38, 41-43 and 45-48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Jonas et al. '515 and Krafft et al. '981. Jonas et al. '515 (see particularly column 1, line 18 - column 2, line 47; column 3, lines 1-30) discloses conductive coatings comprising polythiophene and compounds as set forth in instant claim 8 to increase conductivity and/or transparency which are applied to imaging products such as silver halide photography, dry plate systems and electrophotography. Jonas et al. also disclose that binders as described in European Patent Publication 564,911 (equivalent to U.S. Patent No. 5,370,981 to Krafft et al.) may be added to their conductive coating compositions. Krafft et al. (see particularly column 1, lines 3-40; column 2, lines 55-60; column 3, lines 45-55) disclose antistatic layers for imaging elements comprising polythiophene which include water soluble ~~binders~~ ^{binders} ~~polymers~~ for better adherence and scratch proofing. Since Jonas

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et al. discloses using the binders of Krafft et al. in their antistatic layers, and Krafft et al. disclose the use of water soluble binders for polythiophene conductive layers as used in Jonas et al., it would be obvious to one skilled in the art to use water soluble binders as disclosed in Krafft et al. in the conductive coatings of Jonas et al. for better adherence and scratch proofing. Also, since Jonas et al. (column 1, lines 18-48) disclose that mixing organic compounds as set forth in instant claim 8 into polythiophene conductive layers improves conductivity and/or transparency, it would be obvious to one skilled in the art to add the organic compounds of Jonas et al. to the thiophene conductive layers of Krafft et al. in order to increase conductivity and/or transparency. While Krafft et al. does not specifically disclose gelatin as water soluble binder for their antistatic layers, gelatin is a well known water soluble binder in the photographic art and is disclosed in the applied prior art as a water soluble binder in the silver halide emulsion layers. Therefore, it would be obvious to one skilled in the art to use well known water soluble binders, particularly gelatin, as the generically called for water soluble binders in the antistatic layers of Krafft et al. for improved ^{adherence} conductivity and/or ^{scratch proofing} transparency.

The comparative Examples in applicant's specification report results in Table I wherein the neutral charge conductivity

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enhancers increase the conductivity of layers comprising polythiophene and gelatin. However, the compounds used in the working examples to increase conductivity are known in the art from Jonas et al. as increasing conductivity in polythiophene conductive layers which may contain water soluble binders. Therefore, the results reported in the specification for adding conductivity enhancers to polythiophene layers and obtaining increased conductivity would be expected by one skilled in the art from Jonas et al. The comparisons in the specification do not show unexpected results from using gelatin binders instead of other water soluble binders since other water soluble binders, e.g. polyvinyl alcohol as disclosed in Krafft et al., are not used for comparisons. Applicant's argument in the remarks for the request for continued examination that Krafft et al. and Jonas et al. do not disclose the use of gelatin in antistatic layers is unconvincing since Krafft et al. generically discloses the use of water soluble binders and gelatin is well known water soluble binder. There is no showing in the specification that polyvinyl alcohol as disclosed in Krafft et al. would not work well as compared to gelatin. The silver halide emulsion layers in Krafft et al. ~~and Jonas~~ contain gelatin. Jonas et al. discloses the use of their antistatic layers in silver halide photography which would obviously contain gelatin silver halide emulsion layers as set forth in Krafft et al.

2. Claims 1-14 and 19-48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Jonas et al. '515 and Krafft et al. '981 as applied in paragraph 1 above further in view of Majumdar et al. '655. The combination of Jonas et al. '515 and Krafft et al. '981 makes the use of conductive antistatic layers comprising polythiophene, water soluble binders, including gelatin, and conductivity enhancers as set forth in instant claim 8 as antistatic layers in various imaging elements obvious to one skilled in the art for the reasons set forth in paragraph 1 above. Also, Majumdar (column 5, lines 22-38) discloses that common examples of photographic elements are gelatin-silver halide emulsion layers containing elements so that the use of gelatin in the silver halide layers of the photographic elements disclosed in Jonas et al. would further be obvious to one skilled in the art. Majumdar et al. (see particularly column 5, lines 1-38; column 7, lines 54-59) discloses that polythiophene containing antistatic layers may be used in various imaging elements including silver halide elements, dye receiving elements and electrophotographic elements, in order to reduce static electricity. Therefore, it would be obvious to one skilled in the art to use the thiophene containing antistatic layers with water soluble binders and conductivity enhancers as set forth in paragraph 1 above in various imaging elements as set forth in Majumdar et al. and in

locations as set forth in Majumdar et al. in order to reduce static electricity.

3. The status of the copending applications cited on page 1 in the specification should be updated.

4. Applicants' argument in the remarks with the request for continued examination that gelatin imaging layers are best coated on gelatin containing antistatic layers is further unconvincing since the instant claims are not limited to directly coating gelatin imaging layers onto the antistatic layers of the instant claims.

5. Claims 1-14, 19-29, 35, 38, 39, 40, 41, 44, 45 and 48 are rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirement. The specification fails to contain a written description of imaging elements as set forth in the instant claims wherein the image forming layers ^{are} ~~are~~ required to comprise gelatin. The use of gelatin in image forming layers is only set forth in the specification for silver halide emulsion layers. The other types of image forming layers disclosed in the specification, e.g. electrophotographic layers, ink jet receiving layers, thermal transfer receiving layers ^{and} ~~if~~ thermally imageable layers, are not disclosed as having gelatin binders. There is no generic disclosure in the specification of using gelatin binders in the imaging layers or specific disclosure of various imaging layers

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containing gelatin binders since gelatin binders are only disclosed for silver halide emulsion layers. There is no disclosure of using gelatin binders for non-silver halide imaging layers as set forth in claim 38, for thermally imageable layers as set forth in claim 39 or for electrophotographic imaging layers as set forth in claim 41.

6. Claim 46 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 46 is outside the scope and inconsistent with its parent claim 43. Claim 46 sets forth a black and white film while claim 43 requires a color image forming layer.

7. The prior art cited in the parent application has been considered.

8. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

January 13, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1100-1752

